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Docket No.: 8697.001.00-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re application of

Stephen DAVID

Confirmation No.: 3194

Application No.: 09/446,951

Group Art Unit: 3627

Filed: February 28, 2000

Examiner: Micheal A. CUFF

For: STEP APPARATUS

Customer No.: 30827

**APPELLANT'S BRIEF**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to a Final Rejection of all pending claims that was mailed on June 17, 2003, and Advisory Action that was mailed on October 28, 2003, and in support of a "Notice of Appeal" filed on December 16, 2003, Appellant hereby submits this Appeal Brief.

The fees required under § 1.17(f) and any required petition for extension of time for filing this brief and fees therefore are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief is transmitted in triplicate.

This brief contains items under the following headings as required by 37 C.F.R. § 1.192 and M.P.E.P. § 1206:

- I. Real Party In Interest
- II Related Appeals and Interferences
- III. Status of Claims

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- IV. Status of Amendments
- V. Summary of Invention
- VI. Issues
- VII. Grouping of Claims
- VIII. Arguments
- IX. Claims Involved in the Appeal
- Appendix A Claims

**I. REAL PARTY IN INTEREST**

The real party in interest for this appeal is: Michael A. Cuff

**II. RELATED APPEALS AND INTERFERENCES**

There are no other appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

**III. STATUS OF CLAIMS**

A. Total Number of Claims in the Application

There are 8 claims pending in the application.

B. Current Status of Claims

C. Claims canceled: 2-28, 31, 33-35, and 38.

D. Claims withdrawn from consideration but not canceled: N/A

E. Claims allowed: N/A

F. Claims rejected: 1, 29, 30, 32, 36, 37, 39, and 40

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G. Claims on Appeal: The claims on appeal are claims 1, 29, 30, 32, 36, 37, 39, and 40.

#### **IV. STATUS OF AMENDMENTS**

The Examiner issued a Restriction Requirement on September 7, 2000 identifying four groups of claims: claim 1-5; claims 6-13; claims 14-28; and claims 29-33. Appellant filed a response to the Restriction Requirement electing claims 1-5 without traverse. The Examiner issued a Non-Final Rejection on November 24, 2000 rejecting claims 1-5 and withdrawing claims 6-33 from consideration. Appellant filed an Amendment on February 26, 2001 amending claims 1 and 3, canceling claims 2, 4, and 5, and adding new claims 34-37. The Examiner issued a Final Rejection on April 20, 2001 rejecting claims 1, 3, 34, 36, and 37 and objecting to claim 35. Appellant filed an Amendment After Final on October 18, 2001 canceling claim 35 and adding claim 38. The Examiner responded to the Amendment filed on October 18, 2001 in an Advisory Action mailed October 30, 2001. In the Advisory Action, the Examiner indicated that Appellant's remarks were considered, that claim 38 contained allowable subject matter, and that claims 1, 3, 35, 36, and 37 were rejected. Appellant filed a Request for Continuing Examination on December 19, 2001 amending claims 1 and 3. Appellant on January 10, 2002 conducted a personal interview with the Examiner to discuss claims 1 and 38 and no agreement was reached. The Examiner issued a Non-Final Rejection on January 30, 2002 allowing claim 38 and rejecting claims 1, 3, 34, 36, and 37. Appellant filed a Request for consideration on April 30, 2002. The Examiner issued a Non-Final Rejection stating that the claims were subject to an Election of Species. Appellant responded by provisionally electing Species IV, covered by Figure 6. The

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Examiner issued a Non-Final Rejection on September 9, 2002 clarifying the Election of Species. Appellant responded by provisionally electing Species IV with traverse. The Examiner issued a Non-Final Rejection on December 31, 2002 rejecting claims 1, 29, 30, 32, 36, and 37. Appellant filed an Amendment on March 31, 2003 amending claims 1, 36, and 37 and adding new claims 39 and 40. The Examiner issued a Final Rejection on June 17, 2003 rejecting claims 1, 29, 30, 32, 36, 37, 39, and 40. Appellant filed a Request for Reconsideration After Final on October 17, 2003. The Examiner responded to the Amendment filed on October 17, 2003 in an Advisory Action mailed October 28, 2003. In the Advisory Action, the Examiner indicated that Appellant's remarks in the Response were considered, but did not place the application in condition for allowance because the arguments were not persuasive. Appellant then filed a Notice of Appeal on December 16, 2003.

Accordingly, the claims enclosed herein as Appendix A reflect claims 1, 29, 30, 32, 36, 37, 39, and 40 as currently pending.

## **V. SUMMARY OF INVENTION**

The present invention relates to a step apparatus.

It is an objective of the present invention to allow easier access to the rear of tray back utility vehicles with a towing hitch.

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**VI. ISSUES**

The issue is whether the Examiner properly rejected claims 1, 29, 30, 32, 36, 37, 39, and 40 under 35 U.S.C. 102(e) as being unpatentable over U.S. Patent No. 5,584,495 to Mason (hereinafter “Mason”).

**VII. GROUPING OF CLAIMS**

For purposes of this appeal brief only, and without conceding the teachings of any prior art reference, the claims have been grouped as indicated below:

Group/Claim(s)

A. Independent claim 1 and its dependent claims 36, 37, and 39, independent claim 29 and its dependent claims 30, 32, and 40.

In Section VIII below, Appellant has included arguments supporting the separate patentability of each claim group as required by M.P.E.P. § 1206.

**VIII. ARGUMENTS**

The issue is whether the Examiner properly rejected claims 1, 29, 30, 32, 36, 37, 39, and 40 under 35 U.S.C. 102(e) as being unpatentable over U.S. Patent No. 5,584,495 to Mason (hereinafter “Mason”).

Claim 1 recites a combination of elements including, for example, “a step portion adapted to be hinged to the mounting portion, wherein the step portion is adapted to be moveable between a first in-use position and a second stowed position whereby the mounting portion is adapted to be secured to a vehicle, the step portion is disposed above a hitch portion and usable with or without the vehicle hitch being in use, and in the second stowed

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position, the step portion is adapted to be adjacent to rear of a vehicle and forward, with respect to the direction of travel of a vehicle, of the hitch.” Mason fails to disclose this element.

First, the examiner states that the upper receiver 26 is the step portion of claim 1. Nowhere does Mason teach or disclose that the upper receiver 26 is a step portion. The upper receiver 26 is intended to prevent a tongue 20 of a trailer from separating from a hitch ball 16. (Col. 4, ll. 16-21.)

Second, if it assumed that the upper receiver 26 is a step portion (which the Applicant does not concede), then the upper receiver 26 still does not meet the above stated element of claim 1. Claim 1 calls for a step portion that is movable between a first in-use position and a second stowed position. When the upper receiver 26 is closed upon the ball it would be in an in-use position. The only other position of the upper receiver 26 that would correspond to a stowed position would be to have the upper receiver rotated open and hanging down along the side of the trailer hitch locking assembly 10. This would not be a viable position for the upper receiver 26 while towing a trailer, because the upper receiver would not be secure and would move about and further it would not serve its primary function of preventing the tongue 20 the trailer from separating from the hitch ball 16.

Finally, in claim 1, the step portion has a second stowed position that is adapted to be forward, with respect to the direction of travel of a vehicle, of the hitch. So even assuming that the upper receiver 26 is a step portion and that it has a stowed position when it is rotated to the side of the trailer hitch assembly 10 (again the Applicant does not concede this), this stowed position would be to the side of the hitch rather than forward of the hitch as required in claim 1.

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Therefore, because Mason does not disclose all of the elements of claim 1 for the various reasons stated above, the applicant states that claim 1 is allowable over Mason.

Claims 29, 30, 32, 36, 37, 39, and 40 all fall together with claim 1. Claims 36, 37, and 39 are also allowable by virtue of their dependence on claim 1, which is believed to be allowable. Further, for reasons discussed above claim 29 and its dependent claims 30, 32, and 40 are also allowable.


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**IX. IX. CLAIMS INVOLVED IN THE APPEAL**

A copy of the claims involved in the present appeal is attached hereto as Appendix A.

Dated: April 14, 2004

Respectfully submitted,

By   
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**APPENDIX A**

**Claims Involved in the Appeal of Application Serial No. 09/446,951**

1. (Previously Presented) A step apparatus, including:

a mounting portion adapted to be secured to a vehicle by a hitch assembly adapted to be mounted to the rear thereof, wherein the hitch assembly comprises a hitch portion adapted to be attached to a towable vehicle; and

a step portion adapted to be hinged to the mounting portion, wherein the step portion is adapted to be moveable between a first in-use position and a second stowed position whereby the mounting portion is adapted to be secured to a vehicle, the step portion is disposed above a hitch portion and usable with or without the vehicle hitch being in use, and in the second stowed position, the step portion is adapted to be adjacent to rear of a vehicle and forward, with respect to the direction of travel of a vehicle, of the hitch.

29. (Original) Step apparatus including:

a mounting portion adapted to be secured to a vehicle by the gooseneck for a ball hitch and wherein said mounting portion is secured to the gooseneck by the hitching ball; and

a step portion supported on said mounting portion.

30. (Original) Step apparatus according to claim 29, wherein said step portion is located in use above the towing hitch.

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32. (Original) Step apparatus according to claim 30, wherein said step portion is mounted to the mounting portion in a manner permitting the step to be moved from an in-use position to a stored position.

36. (Previously Presented) The step apparatus according to claim 1, wherein said step is adapted to be locked in a first position, whereby the towable vehicle adapted to be attached to the hitch portion is unable to be detached therefrom.

37. (Previously Presented) The step apparatus according to claim 1, wherein said step is adapted to be locked in said first position, whereby the towable vehicle adapted to be attached to the hitch portions aid hitch is unable to be detached thereto.

39. (Previously Presented) The step apparatus of claim 1, further comprising a pivot pin about which the step portion is adapted to be hinged to the mounting portion.

40. (Previously Presented) The step apparatus of claim 39, further comprising two opposed lugs, wherein the pivot pin is adapted to be mounted to the lugs, wherein each lug has an upper bearing surface which is adapted to support the underside of the step portion when the step potion is in the first position.